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John P. Downs

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN P. DOWNS

Appeal 2009-009496
Application 10/770,139
Technology Center 1700

Decided: January 27, 2010

Before CHUNG K.PAK, CHARLES F. WARREN and PETER F. KRATZ,
Administrative Patent Judges.

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 3, 5, 7, 9-14, 16, and 20. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' claimed invention is directed to an adhesive dispensing tape including a flexible carrier tape with a plurality of adhesive segments disposed non-contiguously on a surface of the carrier tape.

Claim 1 is illustrative and reproduced below:

1. An adhesive dispensing tape comprising:

a flexible carrier tape having a transverse width defined by first and second edges of said carrier tape and a longitudinal length comprising a plurality of adjoining longitudinal segments extending along the entire longitudinal length of said carrier tape, each of said longitudinal segments extending the entire transverse width of said flexible carrier tape; and

a plurality of hot melt adhesive segments disposed non-contiguously spaced apart and aligned in columns extending along said longitudinal length of said carrier tape, wherein at least two separate ones of said adhesive segments are disposed on said carrier tape within each of said longitudinal segments and positioned aligned in side-by-side relation at transversely separated locations between said first and said second edges of said carrier tape to provide transversely extending margin between an outer edge of an adhesive segment and an adjacent one of said first and second edges of said carrier tape in each of said longitudinal segments that is at least equal to the largest transverse extent of the adhesive segment; and

wherein each of said adhesive segments is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed.

The Examiner relies on the following prior art reference as evidence in rejecting the appealed claims:

Torrey

3,741,786

Jun. 26, 1973

Claims 1, 3, 5, 7, 9-14, 16, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Torrey.

We affirm the stated rejection for substantially the reasons set forth in the Examiner's Answer, including the relevant substance of the Examiner's factual determinations with respect to the teachings of Torrey and the Examiner's rebuttal of Appellants' arguments. We offer the following for emphasis.

In deciding this appeal, we have considered independent claims 1, 7, and 16 separately to the extent separately argued by Appellants (App. Br. 8-19). In this regard, we note that pointing out what a particular claim covers is not an argument for the separate patentability of that claim. The dependent claims stand or fall together with the respective independent claim from which they depend. Moreover, we note that the argued functional limitation respecting the individual exposable and dispensable characteristic of the dispensing tape adhesive segments is common to all of the rejected and appealed claims and sets up the principal issue before us with respect to all of the rejected claims as follows:

PRINCIPAL ISSUE

Have Appellants established reversible error in the Examiner's obviousness rejection by urging that the tape of Torrey does not teach or suggest a tape with adhesive segments that are individually dispensable as required by each of appealed claims 1, 7, and 16, because Torrey requires a tape that includes adhesive segments that are disposed on a tape in a manner that allows for dispensing of multiple discrete segments to a substrate at a given time?

PRINCIPLES OF LAW

On appeal to this Board, Appellants must show that the Examiner erred in finally rejecting the claims. *Cf. In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

A claimed invention is not patentable if the subject matter of the claimed invention would have been obvious to a person having ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 13 (1966).

In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, we are guided by the basic principle that the question under 35 U.S.C. § 103 is not merely what the prior art expressly teach but what it would have suggested to one of ordinary skill in the art at the time the invention was made. *See Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807-08 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). That is, the question of obviousness cannot be approached on the basis that an artisan having ordinary skill would have known only what they read in the applied prior art, because such artisan is presumed to know something about the art apart from what the applied reference(s) disclose. *See In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962).

Nor is it necessary that suggestion or motivation be found within the four corners of the reference(s) themselves. “The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of . . . the explicit content of issued patents.” *KSR*, 550 U.S. at 419. Indeed, a

conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *See In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969). After all, it is well settled that “[t]he person of ordinary skill [in the art] is a hypothetical person who is presumed to be aware of all the pertinent prior art.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962-63 (Fed. Cir. 1986).

Whether a rejection is made under 35 U.S.C. § 103 as here, or under § 102, it is appropriate that when Appellants’ product and that of the prior art appear to be identical or substantially identical the burden can be shifted to Appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics of Appellants’ claimed product. *See In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. *See Best*, 562 F.2d at 1255.

As our reviewing court stated in *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997):

A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In other words, when an applicant presents a functionally recited claim proviso merely calling for an intended use of a claimed product, which possible use or capability does not reasonably appear to require any substantive structural modification of a substantially corresponding product that is taught/suggested by the applied prior art, such a clause could be reasonably characterized as an intended use limitation and correctly dispensed with as failing to impart a patentably distinct structural limitation to the claimed subject matter, absent compelling argument/evidence establishing the contrary. *See, e.g., In re Schreiber*, 128 F.3d at 1477-1478.

“During examination, ‘claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

DISCUSSION

Appellants argue that the Examiner erred in characterizing the functional language of claims 1 and 7 “wherein each of said adhesive segments is individually exposable and dispensable to an abutting planar surface when the carrier tape is transversely flexed” and in similarly

characterizing the corresponding language of claim 16, “wherein an individual adhesive segment is individually exposable and dispensable to a single substrate when the carrier tape is transversely flexed” as intended use language that does not serve to patentably distinguish the claimed product from the product taught/suggested by Torrey (App. Br. 9-11). We disagree.

Appellants disclose that their tape includes opposed first and second release surfaces on a flexible carrier that can be rolled and includes spaced adhesive segments on such a carrier release surface (Spec. para., 0006).

Torrey discloses a transfer tape that includes a flexible carrier material made from a material such as polyester or paper, with opposing first and second release surfaces having release coatings, such as silicone based coatings with one surface having a greater release capability than the other, and a plurality of pressure sensitive adhesive segments non-contiguously (without overlap) applied to one of the carrier’s release surfaces for providing spaced segments such that dispensing any portion of the adhesive onto objects can occur (*see*, e.g., abst., col. 1, l. 58 - col. 2, l. 16, col. 2, ll. 23-38, col. 3, l. 1- col. 4, l. 39, col. 5, l. 35 - col. 6, l. 17, col. 6, ll. 27-37).

In this regard, Appellants do not persuasively dispute the Examiner’s determination that:

Torrey relates to an adhesive dispensing tape (10) comprising a flexible carrier tape (12) having a transverse width, a row of adhesive segments (14) spaced apart along the longitudinal length of the tape and transversely in side-by-side relation, each segments being disposed between the two side edges, and can be transferred by flexing the tape. The adhesive is pressure sensitive adhesive (PSA) (col. 3, line 30) and applied to the carrier in a hot melt form, hence it includes hot melt adhesive. The carrier tape is provided with first and second release surfaces such that the adhesive segments adhere

less strongly to the second release surface when unwound from a roll (col. 2, lines 8-12 and col. 3, lines 5-12). The adhesive segments are centered along the transverse width of the tape to form a longitudinally straight line as shown in figure-1. The segments can be of any shape such as dots, bars, star, triangle, etc. or any pattern without any criticality (col. 3, lines 57-68). The dot shape would exhibit circular configuration. The transverse position of each segment is distinct as shown by their separate position along the tape length. In col. 6, lines 32-37, Torrey teaches that any portion of the adhesive can be transferred from the carrier tape to a substrate, thereby indicating that each adhesive segment[s] is individually exposable and dispensable. Further, figure-1 shows that the each of the tape edge is at least equal to the adhesive segments.

Torrey does not explicitly provide wording stating a use or function of a tape wherein each non-contiguous segment of adhesive on a carrier material is separately dispensed to a desired object, via pressure application, when the carrier material is transversely flexed.

However, concerning the argued claim proviso for individual dispensability of the spaced pressure-sensitive adhesive segments via carrier tape transverse flexing, we note that this functional/intended use capability would have reasonably been expected to be possessed by the dispensing tapes taught and/or suggested by Torrey given the common materials employed by Torrey and those disclosed by Appellants; that is, the flexible tape and non-contiguous adhesive segments disposed on a tape release surface of Appellants (Spec. para., 0006), the spaced configuration of the adhesive segments of Torrey, and the obviously flexible nature of the tape of Torrey (it can be rolled too). Appellants have not established otherwise by their non-substantiated arguments to the contrary that seemingly assert that Torrey's tape is only capable of releasing multiple adhesive segments to an

object based on a restricted view of a disclosed utility/use for the tape allegedly provided by Torrey. In this regard, Appellants have not provided persuasive technical reasoning or even a rationale basis to establish that this argued disclosed utility of the tape of Torrey would serve as a limitation on the tape construction of Torrey that would serve to foreclose other functional capabilities/uses of the tape constructions taught or suggested by Torrey, such as the use/capability of the tape to expose and dispense one of the discrete adhesive segments thereon at a time (*see generally* App. Br. and Reply Br.). In this regard, we note that Appellants also disclose that their tape can function to dispense more than one adhesive segment at a time and we note that separately argued claims 1, 7, and 16 do not preclude other uses of the claimed tape - including the dispensing of multiple adhesive segments at a time to a surface from the tape product claimed therein (Spec. para., 0014; claims 1, 7, and 16). In other words, Appellants have not shown, much less identified, any structural difference between the claimed and prior art adhesive segments dispensing tapes, which is responsible for the claimed functionality. As implied by the Examiner, if a product taught or suggested by the prior art seemingly corresponds to a claimed product in recited structure such that the prior art product would reasonably appear to be capable of performing a claimed functionality (use) of the claimed structure, it follows that the recitation of such a functional (use) claim limitation does not define further structure that patentably distinguishes over the applied prior art (Ans. 6).

On this record, Appellants have not carried their burden to show that the argued functional claim language defines a non-obvious structural

feature of the claimed subject matter that the tapes made in accordance with Torrey's teachings and suggestions would not possess.

Appellants argue that Torrey fails to teach or suggest adhesive segments being aligned in a side-by side fashion, in aligned columns, in transversely separated locations, and/or with a margin extending from the tape carrier tape outer edge to the adhesive segment as these features relate to the requirements of claims 1, 7, and/or 16 (App. Br. 11-19). However, we agree with the Examiner that Torrey provides ample teaching and suggestion that would have led one of ordinary skill in the art to produce a tape having non-contiguous/spaced adhesive segment arranged in columns and or side-by-side fashion while being spaced from each other and the carrier tape edge by a suitable distance for separate dispensing thereof, including distances between segments equal to the traverse or longitudinal extent of an adhesive segment, as variously called for in claims 1, 7, and 16 (Ans. 4-7).

In this regard, we note that Torrey makes it plain that the adhesive segments can be formed in the shape of dots or other shapes, spaced from each other, arranged in any desired pattern, including a regular or irregular pattern, and separated from the carrier tape edge by a margin (*see, e.g.*, col. 3, ll. 57-75, col. 5, l. 70 - col. 6, l. 31; col. 1, l. 58 - col. 2, l. 38; Figs. 1 and 4).

Consequently, we agree with the Examiner that it would have been obvious for one of ordinary skill in the art to select a spaced pattern of adhesive segments corresponding to the claims 1, 7, and/or 16 requirements to yield an adhesive transfer tape that can dispense the non-contiguous adhesive segments individually or in multiples of segments, as may be desirable for a particular utility for the dispensed adhesive. After all, "[i]t is

common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 402. This is especially the case here, where the teachings required to be fitted together are found in the same reference as options, where the involved subject matter relates to known adhesives and known materials used for films and adhesive carriers with respect to an adhesive transfer tape, and where the art recognized alternatives for dispensing and uses of such adhesive would have been intuitively obvious and predictable to an ordinarily skilled artisan. Consequently, even if Torrey were not considered to implicitly describe a tape that has an individual adhesive segment dispensing capability as argued, a proposition with which we disagree, we are satisfied that the adhesive segment shape and spacing alternatives taught by Torrey would have led an ordinarily skilled artisan to the construction of a transfer tape with adhesive segments spaced, as claimed, that permits individual and multiple adhesive segment dispensing options. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. 398 at 416. The question to be asked is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

CONCLUSION

Appellants have not established reversible error in the Examiner’s obviousness rejection by urging that the tape of Torrey does not teach or suggest a tape with adhesive segments that are individually dispensable as

required by each of appealed claims 1, 7, and 16, because Torrey teaches or suggests a transfer tape that includes non-contiguous adhesive segments that are disposed on a tape in a manner that is suggestive of a tape, as claimed, that would permit dispensing multiple or individual discrete adhesive segments to a substrate at a particular time.

ORDER

The Examiner's decision to reject claims 1, 3, 5, 7, 9-14, 16, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Torrey is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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